

In response to Applicants' previous argument, submitted with Amendment A, that the electrode/metal contact 15 of Yoshikawa plays no role in the formation of porous silicon in Yoshikawa (nor, incidentally, does it play a role in forming porous silicon in Russell or any of the references of record), the Office Action responds, "This argument does not commensurate with the scope of claims 1, 11, 21 because although the examiner recognizes that Yoshikawa discloses forming the electrode 15 after the formation of porous silicon, the limitations in claims 1, 11, 21 do not require the use of a discontinuous metal layer in the formation of porous silicon."

Applicants respectfully traverse the Office Action's statement. Each of claims 1, 11, and 21 specifically state, "A method for producing porous silicon" in its preamble. This statement should bear weight as to the purpose of the invention claimed. As clearly stated in, for example, MPEP § 2111.02, "If the claim preamble, when read in the context of the entire claim, recites limitation of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." The statement, "A method for producing porous silicon" clearly intends to give meaning to the claim; i.e., that the steps defined are steps for producing porous silicon.

In Russell and Yoshikawa, by contrast, a metal electrode is applied to already-produced porous silicon. This is correctly recognized by the Examiner. However, the Office Action repeatedly analyzes the prior art not for its teaching regarding producing porous

silicon as claimed, but instead for teaching steps in “a method for forming a light-emitting device”. Though Applicants recognize that porous silicon produced according to the defined methods may be used for a light-emitting device, the pending claims themselves are directed to producing porous silicon. None of the art of record teaches, alone or in combination, a step in a process for producing porous silicon that includes at least depositing a thin discontinuous layer of metal on a Si surface, nor does the art alone or in combination disclose or suggest a method of producing porous silicon having the combination of steps defined in claims 1, 11, and 21. The art cited teaches away from the invention at least by teaching that metal is applied only after porous silicon is formed by some other method.

Additionally, the Office Action states that claims 1, 11, and 21 do not require depositing a thin discontinuous layer of metal on an Si surface before etching. Applicants respectfully traverse this statement, as the claims, when read by one of ordinary skill in the art, would be understood to define, among other things, that the thin layer of metal is deposited before the step of etching the Si surface.

For at least the above reasons, Applicants respectfully submit that claims 1, 11, and 21 are allowable over the references of record, alone or in combination. Claims 2-10 and 12-20, having at least the features of respective independent claims 1 and 11, are believed to be similarly allowable for at least the reasons stated above as applied to their respective independent claims. Reconsideration and allowance of claims 1-21 are respectfully requested.

For the foregoing reasons, Applicants believe that this case is in condition for allowance, which is respectfully requested. The Examiner should call Applicants' attorney if an interview would expedite prosecution.

Respectfully submitted,

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